

### **REMARKS/ARGUMENTS**

Applicant thanks the Examiner for the professional courtesies extended in a telephone interview with Applicant's counsel on September 23, 2009.

#### *Status*

This reply is in response to the Office Action mailed June 24, 2009 in which the following rejections were set forth: Claims 1-3, 5-9, and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and further in view of *Akeel*; Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 5,855,062, issued to Kendall ("Kendall"); Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 4,962,724, issued to Prus ("Prus"); and Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ott* in view of *Herre* and *Akeel* as rejected under Claim 1, and further in view of U.S. Patent No. 2,784,350, issued to Sedlacsik ("Sedlacsik").

By this response, Claim 13 has been added, and no claims have been amended or canceled. As such, Claims 1-13 are pending in this application.

#### *Claim Rejections*

For prior art references to be combined to render obvious an invention under 35 U.S.C. § 103(a), there must be something in the prior art as a whole that suggests the desirability, and thus, the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). Furthermore, hindsight is strictly forbidden and it is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *In re Fine*, 5 U.S.P.Q.2d at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. When the prior art fails to suggest the claimed invention, any reconstruction of the prior art to obtain the invention necessarily and inevitably requires impermissible hindsight. If selective combination of the prior art references is required to render the invention obvious, there must be some reason for the combination other than hindsight gleaned from the invention itself. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.

Applicant's invention is directed to a paint transportation system utilizing two pigs to repetitively transport paint from a paint source to a paint application device. At a first pig

station, the paint is inserted into the pipeline and retained within two pigs. The two pigs transport the paint to a second pig station, wherein the paint is provided to the paint application device. Any residual paint remaining between the two pigs is removed while the pigs are being temporarily stored at a second pig station via a valve ultimately connected to a discharge line. A cleaning agent is then inserted into the pipeline and retained within the same two pigs, wherein the cleaning solvent is transported back to the first pig station.

Referring now to the relied upon prior art, *Ott* is directed to a paint transportation system that utilizes two pigs. Although *Ott* discloses a two pig paint transporting system—which is similar to Applicant's invention in this regard—*Ott* fails to disclose several significant and claimed aspects of Applicant's invention. Most notably, and as admitted in the Office Action, *Ott* fails to disclose how to clean the paint lines or how to discharge the residual paint remaining between the two pigs when the paint process has been completed. In sum, *Ott* fails to disclose, at least:

- the pig line being cleaned on the return path of the pigs from the second to the first pig station by means of a give quantity of cleaning agent that is conveyed by at least one pig;
- the cleaning agent being transported between the two pigs on return from the second pig station to the first pig station; and,
- the residual paint remaining between the two pigs after completion of the painting process being disposed via the second pig station.

Thus, and as admitted in the Office Action, *Ott* fails to disclose each and every feature of Applicant's amended Claim 1.

Now considering *Herre*, it discloses a paint transportation system utilizing two pigs, however the two pigs of *Herre* do not convey paint, but only cleaning solvent in both directions—toward the paint application device and toward the paint canister. That is, paint is never conveyed between the two pigs in *Herre's* system.

That is, when paint is delivered to the application device in *Herre*, a solvent is supplied between the two pigs at the first pig station and the solvent and pigs are conveyed toward the application device and beyond the paint source/canister. In other words, paint is pressed into the supply line and conducts the pigs containing the solvent there between in the direction toward the application device and the second pig station. When the solvent between the pigs reaches the

supply line in front of the second pig station, the solvent is pushed towards the application device. While the pigs are arranged within the second pig station, the paint is then pushed toward the application device and the paint process occurs. Upon completion of the painting process, solvent is again reintroduced between the two pigs and conveyed back toward the first pig station. Thus, at no time does *Herre* disclose a paint conveying system wherein paint is conveyed by two pigs. *Herre* only discloses solvent being conveyed between two pigs. As such, Applicant contends that *Herre* fails to disclose:

- a given paint volume being conveyed between two pigs;
- a passage of the first pig station extending between a connection to the paint supply source and a connection to the pig line, and a passage of the second pig station extending between a connection to the pig line and a connection to the paint application device; and,
- disposing via the second pig station, the residual paint remaining between the two pigs when the painting process has been completed.

Similarly, Applicant contends that the combination of *Ott* and *Herre* also fails to suggest to one of ordinary skill in the art Applicant's Claim 1. That is, *Herre* leads only to the conclusion that in cases where the space between two pigs is used for conveying a solvent, the paint must be conveyed in the form of a paint flow through the whole system but not in the form of a paint packet between the two pigs. There simply is no suggestion to be found in *Herre* to fill the space between the two pigs with paint for conveying a paint packet.

Furthermore, considering the teachings of *Ott* and *Herre*, Applicant contends that their combination only teaches to one of ordinary skill in the art that either a paint packet or a solvent packet could be conveyed between two pigs, but not that a paint and a solvent could be alternatively conveyed between two pigs without substantial difficulty—e.g., contamination of the paint by the solvent or the disposal of residual paint. Applicant's invention is directed to addressing these and other concerns.

Despite the commonality that *Ott* and *Herre* relate to a paint transport system, because the mechanism utilized by each reference are significantly different, Applicant asserts that a person having ordinary skill in the art would not look to *Herre* to compensate for *Ott*'s shortcoming to disclose cleaning the paint line with a solvent for various reasons. For instance, *Ott* discloses a two pig paint transporting system as opposed to *Herre*'s disclosure pertaining to

arguably a single pig, or no pig, paint transportation system. And even if a person of ordinary skill in the art would look to *Herre* for disclosing a “cleaning process,” incorporating *Herre*’s cleaning process into *Ott* would not result in Applicant’s claimed invention; but rather, would result in either a paint conveyor system utilizing three pigs wherein a packet of solvent contained within the first and second pigs leads a packet of paint contained between the second and third pigs; or, *Ott* would be modified to transport the solvent between the first two pigs and paint would be pressurized through the pipe line behind the solvent. In either instance, the combination of *Ott* and *Herre* would not result in Applicant’s claimed invention wherein paint is transported between two pigs on the way to the application device, and then solvent is transported between the same two pigs on the way back to the paint source. As such, the combination of *Ott* and *Herre* discloses, at most, a paint conveying system wherein only paint is conveyed between two pigs, or only solvent is conveyed between two pigs, but not paint and solvent being separately conveyed between two pigs. And thus, the combination of *Ott* and *Herre* fails to disclose paint and solvent being separately conveyed between two pigs.

Referring now to *Akeel*, it discloses a paint conveying system including a cleaning process, however no pigs are utilized to transport paint or cleaning solvent. That is, paint is pushed through the line without utilizing a pig(s). When cleaning is desired, a single pig is introduced into the system to clean the pipe and carry paint residue toward a drain, after which a cleaning solvent is introduced into the line. The single pig is discarded from the system, presumably to be reused at a later time.

Applicant submits that it is readily apparent that *Akeel* fails to compensate for *Herre*’s shortcoming of disclosing paint and solvent being separately conveyed between two pigs—as well as the removal of paint between two pigs. As such, the combination of *Ott*, *Herre*, and *Akeel* obviously fails to disclose each and every element of Applicant’s invention as claimed.

Assuming now for the sake of argument that *Ott* and *Herre* are properly combinable, and as such, disclose Applicant’s claimed invention but for the dispersal of residual paint, Applicant asserts that *Akeel* is not properly combinable with *Ott* and *Herre*. In other words, a person of ordinary skill in the art would not look to *Akeel* to compensate for the shortcomings of the combination of *Ott* and *Herre* to disclose a mechanism for removing residual paint. Although *Akeel* discloses, in the broadest sense, the removal of residual paint from the paint line, it is not proper to merely select the functional aspect disclosed in *Akeel*’s and combine it with other

references.<sup>1</sup> But rather, the mechanism associated with such functionality as taught by *Akeel* must also be considered. And in fact, the mechanism for removing residual paint as disclosed in *Akeel* cannot be incorporated into *Ott* and/or *Herre* without significantly altering the systems of *Ott* and/or *Herre*. Furthermore, the provisional combination of *Ott* and *Herre* provides no motivation for removing residual patent. For one thing, *Ott* is not even concerned with cleaning the pipe line. As such, there is no incentive for *Ott* to remove residual paint from between the two pigs in preparation of inserting cleaning solvent there between. Furthermore, *Herre* never transports paint between the two pigs and therefore there is no reason to remove paint from between the two pigs in preparation of inserting a cleaning solvent there between because paint never resides between the two pigs.

Moreover, incorporating the sole technique for removing residual paint as taught in *Akeel* into *Ott* and/or *Herre* cannot be accomplished without significantly changing the systems of *Ott* and/or *Herre*. Put differently, *Akeel* discloses simply sending a sole pig through the paint line to facilitate removal of residual paint and then jettisoning the pig from the paint line entirely. Incorporating such a technique into the two-pig system of *Ott* and/or *Herre* would require a substantial reconstruction and redesign of the elements shown in *Ott* and/or *Herre* as well as a change in the basic principle under which the *Ott* and/or *Herre* construction was designed to operate, and in fact, would render such construction essentially inoperable.<sup>2</sup>

And with respect to the “residual paint removal” aspect that *Akeel* allegedly discloses, Applicant asserts that no where within the cited prior art is it disclosed that the *Akeel*’s dump valve be positioned proximate the pig station and between the two pigs. Again, *Ott* is neither concerned with cleaning, nor the removal of residual paint and as such, no suggestion or motivation is provided therein for the inclusion or placement of a “dump valve.” In *Herre*, paint is never conveyed between the two pigs and therefore a “dump valve” is not required to be located proximate the pig station and between the pigs for discarding residual paint there from. So *Herre* provides no motivation or suggestion for location of the “dump valve.” And in regard

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<sup>1</sup> “Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

<sup>2</sup> “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” See *MPEP* § 2143.01 VI.

to *Akeel*, it fails to disclose a pig station altogether. As such, no motivation or suggestion exists within *Akeel* for the location of the “dump valve.”

In view of the above reasoning, Applicant asserts that the Examiner has failed to present a *prima facie* case of obviousness. Furthermore, because the relied upon cited prior art, alone or in combination, fails to disclose, teach, or suggest each and every element of Applicant’s independent Claim 1—as well as all claims ultimately dependent thereon—Applicant submits all pending claims are in condition for allowance and respectfully requests that the rejections to all pending claims be withdrawn.

*New Claims*

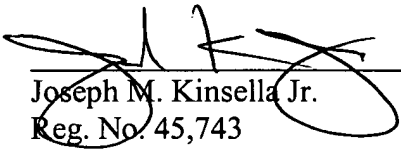
Applicant’s new Claims 13-16 is similarly directed to method of supplying a paint application device with paint from a paint supply source. Applicant asserts that these new claims include severable patentable aspects not disclosed by the cited prior art, alone or in combination. Applicant therefore respectfully submits that these new claims are in condition for allowance.

**CONCLUSION**

Based upon the above remarks, Applicant respectfully requests that all rejections be removed and all pending claims be passed to issuance. If any additional fees are required with this communication, Applicant herein authorizes the Commissioner to deduct such fees from Deposit Account No. 50-0545.

Respectfully Submitted,

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